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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,415	01/02/2001	Paul J. Rank	30014200-1078	3147

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EXAMINER
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VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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08/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/754,415

Applicant(s)

RANK, PAUL J.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Action Background***

1. This action is responsive to the applicant's amendment filed 6/4/2007.
2. Applicant has amended claims 1, 3-5, 8, 9, and 11-16, and canceled claims 2 and 10.
3. Claims 1, 3-9 and 11-16 are pending in the case, claims 1 and 9 are independent claims.
4. The examiner's rejection of claim 1, made under 35 USC 102(e), as being anticipated by Hutchinson, US Patent 6,405,246 (as recited in the office action dated 1/25/2007) is withdrawn as necessitated by the amended claims, however, new grounds of rejection are described below.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

6. Claims 1, 3, 5, 6, 8, 9, 11, 13, 14 and 16 are rejected under 35 U.S.C. 102(b) as being unpatentable over Hutchinson in view of Barile et al., US Patent 5,977,886, filed 10/10/1997, patented 11/2/1999 (hereinafter "*Barile*").

7. **Regarding independent claim 1**, Hutchison discloses automatic and dynamic software code management for a PDA; see column 2, lines 57-60). Hutchinson discloses determining at least one function associated with a file download and dynamically downloading the file and the function. Hutchinson recites: *"the data processing apparatus has: a receiving unit for receiving a request on a target object; an activating unit for activating the target object if the target object is inactive; and a dispatching unit for dispatching the request to the target object for execution thereby; wherein the activating unit determines whether software components which it needs to activate the target object are stored locally and if it determines that the software components are not stored locally the activating unit downloads such*

*software components over the network from the second data processing apparatus" (abstract).*

Hutchinson discloses downloading a file and a function as described above. Hutchinson fails to disclose obtaining the function based upon user preferences. Barile discloses user preferences that are considered during file handling. Barile recites: *"This and other objects, features and advantages are provided according to the present invention by systems and methods for communicating a user input to an application resident on a data processing system, in which a user input accepted at a user input device is communicated using a code which is a member of a code set which is adaptively selected to optimize a performance parameter for communicating user inputs to the application"* (column 2, lines 3-10).

Therefore, It would have been obvious, to one of ordinary skill in the arts, at the time the invention was made, to consider user preferences as taught by Barile with the dynamic software code management of Hutchinson in order to provide *"a user input accepted at a user input device is communicated using a code which is a member of a code set which is adaptively selected to optimize a performance parameter for communicating user inputs to the application"* (Barile, column 2, lines 6-10).

8. **Regarding dependent claim 3**, Barile recites: *"For example, a user input device may utilize keycodes for an English-text word processing application in a different fashion than for a word processing application in a different language or a specialized text processing application such as a computer*

*program editor*" (column 2, lines 24-29). Compare *"family of functions"* with *"keycodes for an English-text word processing application"*.

9. **Regarding dependent claims 5 and 6**, Barile recites: *"However, the keyboard 10 and PDA 20 may be used for applications other than English-text word processing. For example, a spreadsheet application may be running on the PDA 20 which involves more numeric keyboard entry than alphabetic character entry ... Therefore, according to the present invention, a different keycode set may be adaptively selected for use with the spreadsheet application"* (column 6, lines 8-17).
10. **Regarding independent claim 9**, the claim is directed toward a computer product for the method of claim 1 and is rejected with the same rationale.
11. **Regarding dependent claim 11**, the claim is directed toward a computer product for the method of claim 3, and is rejected with the same rationale.
12. **Regarding dependent claims 13 and 14**, the claims are directed toward a computer product for the method of claims 5 and 6, and are rejected with the same rationale.
13. **Regarding dependent claims 8 and 16**, the claims are rejected for fully incorporating the deficiencies of the base claims
14. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchinson in view of Barile, and in further view of Bukszar

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et al. US Patent 6,133,916, filed 4/8/1998, patented 10/17/2000 (hereinafter Bukszar).

15. **Regarding dependent claim 4**, Hutchinson and Barile disclose determining a function as described above. Hutchinson and Barile fail to disclose displaying the function as a list. Bukszar teaches displaying functions as a list. Bukszar recites: "*Alternatively, various functions can be accessed by clicking a mouse button while the mouse pointer is in the vicinity of a graphical representation 46A-E to display a list of functions applicable to the display of the graphical representation*" (column 4, line 64 to column 5, line 1).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine displaying a list of functions, as taught by Bukszar, to the subset of function determination of Hutchinson and Barile to provide the benefit of allowing system users the ability to see and access the available functions of the system.

16. **Regarding dependent claim 12**, the claim is directed toward a computer product for the method of claim 4 and is rejected with the same rationale.
17. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchinson in view of Barile, in further view of Hoffberg et al. US Patent 5,901,246, filed 6/6/1995, patented 5/4/1999 (hereinafter Hoffberg).

18. **Regarding dependent claim 7**, Hutchinson and Barile disclose a family of functions as described above. Hutchinson and Barile fail to disclose mathematical, trigonometric, statistical, financial or scientific functions. Hoffberg teaches the use of financial and scientific functions. Hoffberg recites: *"if the text and context of the table indicate that this is a financial table, financial options would be initially provided, and standard financial calculation functions immediately made available or performed, in contemplation of their prospective use. Similarly, if the data appears to be scientific, a different set of options would be initially available, and the standard scientific-type calculation functions be made available or performed"* (column 107, lines 33-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the use of financial or scientific functions as taught by Hoffberg with Hutchinson and Barile's family of functions in order to allow users the ability to use built in complex functions.

19. **Regarding dependent claim 15**, the claim is directed toward a computer product for the method of claim 7 and is rejected with the same rationale.



***Response to Arguments***

20. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection, as described above
21. Applicant's arguments filed 6/4/2007, related to the rejections of claims 3-9 and 11-16 have been fully considered but they are not persuasive.
22. **Regarding independent claims 1 and 9**, applicant argues that: "*Barile fails to disclose or suggest receiving a user input that indicates a user preference of desired functions and determining at least one function of a set of functions responsive to the user input*" (page 7, last paragraph of the response filed 6/4/2007). Applicant is directed to the rejection of claims 1 and 9, as stated above. Hutchinson teaches automatic and dynamic software code management for a PDA; and determining at least one function associated with a file download and dynamically downloading the file and the function, as described above. Barile teaches user preferences that are considered during file handling, as described above. The motivation for combining these references are described above. Applicant's arguments on pages 8 and 9 of the response filed 6/4/2007 are substantially the same.

***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

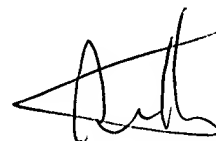
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER

/Gregory J. Vaughn/  
Patent Examiner  
August 15, 2007